

REMARKS/ARGUMENTS

Claims 1, 5, 6, 8-11, 15, 16, 18, and 19 remain pending in this application. Of these claims, claims 1, 5, 6, 8-11, and 16 have been amended. Claims 2 and 12 have been cancelled. For at least the reasons stated below, Applicants assert that all claims are in condition for allowance.

Interview

On October 21, 2002, Examiner granted an interview, which was conducted with Glenn Edwards (Reg. No. 44,426) and Christopher Hilberg (Reg. No. 48,740), attorneys for Applicants. Applicants would like to express sincere appreciation for the Examiner's time. Examiner's comments during the interview were extremely helpful in assisting Applicants in understanding the Examiner's position on the present application. In addition, Examiner's comments demonstrated time invested into reviewing this case prior to the interview and were responsive to Applicants' inquiries. Further, Examiner expressed specific matters that may advance the prosecution of this application, and Applicants have attempted to address those matters herein.

Applicants would further like to thank the Examiner for indicating during the interview a willingness to entertain the amendments contained herein and the courtesy of considering those amendments at this time.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1, 5, 6, 8-11, 15, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chrabaszez*, U.S. Patent No. 6,202,083 in view of *Harris et al.*, U.S. Patent No. 6,331,972. Because these references, alone or in combination, fail to teach or suggest each element of the claimed invention, Applicants oppose this rejection.

Response to Examiner's Interview Requests

During the course of the interview on October 21, 2002, Examiner expressed that both a concise statement of the present invention as well as citations to particular sections of the specification and drawings in this application would be helpful. In response to Examiner's requests, such descriptions of the invention are provided.

The present invention generally provides for sharing user profile information, which is stored on a centralized database and may be used by third parties for providing customized personal services to the user. The preambles of independent claims 1, 10, and 11 have been amended to clearly indicate their content as being generally directed towards this invention.

The user profile information is accessible by the user from any Internet enabled device, and the user may grant third parties access to a subset of the user profile information. The user may also maintain and access various activities on the database (e.g. a calendar object or task list object), and the user may synchronize any Internet-enabled device, from any location, with the database. More specifically, the claims capture the novel combination of two important improvements over other

systems: (1) a third party may access a subset of the user profile information, stored on a centralized database, and provide customized personal services to the user based on the subset of information; and (2) the user may store and synchronize, with any Internet-enabled device, various activities on the same centralized database.

As previously noted, Examiner also requested citations to particular sections of the specification and drawings in this application. Per claim elements (a) and (b), the personal information identified in claim elements (a) and (b), namely user profile information and Activities, are stored in the centralized database. (see p. 76, ln. 18-20, "this system provides one central storage place for a person's profile"; see also p. 68, ln. 22-25; p. 70, ln. 5-8). This aspect of the present invention is also shown in Figure 17 (illustrating the profile database, element 1710) and Figure 10A (element 1060), and is further described on page 70, ln. 5-8: "The Customer Profile Database 1060 contains personal information about the customers, such as name, address, social security number and credit card information, personal preferences, behavioral information, history, and web site layout preferences." Additionally, this personal information may be entered and stored through a logistics display shown in Figure 21 (See also, p. 80, ln. 11-22, noting how profiles can be selected and updated).

Per claim elements (c) and (e), the user and a third party are provided access to the centralized database and the profile information on the centralized database (see p. 77, ln. 4-18). Additionally, the profile gateway server is configured between the centralized database and the Internet enabled device and the third party. This specific arrangement is illustrated in Figure 17, which shows a plurality of Internet enabled devices 1740, the profile database 1710, the third party merchant 1750, and the profile gateway server 1720 situated between the centralized database and the other elements.

Per claim element (d), the user provides permission to third parties to access specific personal information; e.g., the user may grant certain merchants permission to access a public subset of the profile information (see p. 77, ln. 15-18; see also p. 77, ln. 26-27, describing how the third party "is then given access to a certain part of the consumer's profile that he has previously specified"). Furthermore, the permission granted to the third party by the user is maintained and implemented by the profile gateway server (see p. 77, ln. 8-9). The permissions information may be entered through the logistics display shown in Figure 21 (see also, p. 80, ln. 11-22, noting how permissions can be set).

Per claim element (f), the third party merchants "will be able to access [the user profile] (given permission from the consumer who owns each profile), and will be able to offer customized, personalized services to consumers because of this." (Specification, p. 77, ln. 15-18). For instance, such customized personalized services may include personalized content (p. 76, ln. 22-23), managing billing information and response to hotel room preferences (p. 77, ln. 26—p. 78, ln. 2), response to movie and dining preferences (p. 78, ln. 2-3), and e-mail notices of specified events (p. 78, ln. 3-4). Per claim (g), transaction information relating to the customized personal services

provided to the user by the third party are then stored in the centralized database. For instance, if the third party is a hotel that provides checkin services for the user, transaction information regarding the checkin would be stored in the centralized database. (Specification, p. 78, ln. 5-7).

Per claim (h), activities (e.g., calendar object, e-mail object, contact list object, task list object, and note object) can be synchronized between the centralized database and a remote, Internet-enabled device. (p. 76, ln. 18—p. 77, ln. 2). For instance, a user with an Internet-enabled PDA can remotely synchronize that device with the same centralized database that contains the user profile information, which can be accessed by third parties.

Relevant Caselaw and Procedure

Section 2143 of the MPEP provides in part, "To establish a *prima facie* case of obviousness ... the prior art reference ... must teach or suggest all the Claim limitations." (emphasis added). The recent decision of the U.S. Court of Appeals Federal Circuit of *In Re Lee*, 61 U.S.P.Q.2d 1430, is particularly pertinent to this issue. At page 1433, the Court addresses the purpose of the Administrative Procedure Act, which requires administrative agencies, including the Patent Office, to not only have reached a sound decision, but to have articulated the reasons for that decision.

This applies to patent prosecution in the office and before the board and subsequent review. In addressing the issue of obviousness the Court noted that rejections under 35 USC § 103 must be based on evidence comprehended by language of the Section. The Court cites a series of cases requiring the showing of a suggestion, teaching or motivation to combine prior art references as an essential component to an obviousness holding. The Patent Office Board of Appeals in the *Lee* matter had rejected the need for any specific hint or suggestion in a particular reference to support the combination of prior art teachings. The Board had relied upon basic knowledge or common sense. In essence, the CAFC required that there be evidence of the showing of a suggestion, teaching, or motivation to combine or modify references.

Cited References Fail to Teach or Suggest All Claim Limitations

In light of the foregoing comments and claim amendments, Applicant respectfully submits that the cited references, alone or in combination, fail to "teach or suggest all the Claim limitations" of the present invention. Further, Applicant asserts that Examiner has not provided evidence of a showing of a suggestion, teaching, or motivation to combine or modify the cited references. Accordingly, Applicant opposes Examiner's § 103 rejections and respectfully requests that they be withdrawn.

The references fail to teach, *inter alia*: (1) a third party accessing a subset of user profile information, which is stored on a centralized database, and providing customized personal services to the user based on the subset of information; and (2) allowing the user to store and synchronize, with any Internet-enabled device, various activities on the same centralized database, as claimed in the present invention.

Chrabaszez Reference

Chrabaszez discloses a method for updating wallpaper for a computer display. Reading the entire disclosure of *Chrabaszez* shows that *Chrabaszez* teaches quite a different application of user profiles than is claimed in the present invention. Specifically, in *Chrabaszez*, upon receiving a request for a wallpaper display, a fetching mechanism references a distributed user database to determine a personal profile for the user who generated the request. The personal profile is used to select a wallpaper from a picture database. *See* col. 4, lines 48-51. The personal profile may contain information on what items and areas the user has referenced in the past and the user's security rights.

Applicant's invention offers the user a single centralized user profile that is easily accessible from anywhere. Under Applicant's invention, the user is able to set up a user profile and store Activities. The user may further grant permissions so that a subset of the user profile information may be shared with third parties. At any point, third parties can access the user profile from the centralized database. The third parties then provide customized personal services to the user, based on the user profile.

Chrabaszez fails to disclose or suggest providing user profile information from a centralized database to a third party, wherein the centralized database also stores activities that may be synchronized with the user's Internet-enabled device, as claimed in the present invention. Nowhere does *Chrabaszez* teach or suggest a centralized database that provides both functions, nor does *Chrabaszez* teach or suggest a third party providing customized personal services (as opposed to wallpaper) to the user based on the user profile information (claim element (f)) and then, as a distinct step, store transaction information regarding the customized personal services in the centralized database (claim element (g)).

Furthermore, *Chrabaszez* discloses a subdivided web site containing a public space and a private space. *See* Figure 2. Any user or person with access to the system can access information in the public space. The public space contains information such as news, sports, and community information. *See* col. 3, lines 54-67. However, only a user with authorization (*i.e.*, a password) has access to the private space. The private space contains an individual user's personal information, such as, member lists, family reunion information, and the like. *See* col. 4, lines 1-25. In contrast, in Applicant's claimed invention, the user has both a user profile and Activities, which are stored on the centralized database. The user can access this profile information anywhere via an Internet-enabled device—such as with a Palm Pilot PDA or cell telephone—as can third parties with permission.

Accordingly, for the foregoing reasons *Chrabaszez* fails to “teach or suggest *all* the Claim limitations” of claims 1, 5, 6, 8-11, 15, 16, 18, and 19, and Applicant respectfully requests that Examiner's § 103 rejections as to these claims be withdrawn.

Harris Reference

Furthermore, *Harris* discloses a method for personalizing an electronic device through a personal area network. *Harris* discloses remote device access to a system. However, reading the entire disclosure of *Harris* shows that the reference teaches quite a different application of third party access and makes no teaching of providing customized personal services. Nowhere does *Harris* teach or suggest user access to a system via a remote or third party electronic device, but rather, *Harris* teaches transmitting transaction information (rather than granting access). Specifically, *Harris* discloses the transmission of messages between remote/third party electronic devices to configure the third party electronic device to display the user data from the system.

Nowhere does *Harris* does teach or suggest (1) a third party having access to the user profile, or (2) providing customized personal services to the user based on the user profile, as claimed in the present invention. Moreover, *Harris* fails to teach or suggest public access to a subset of the user profile information, as claimed in the present invention.

Accordingly, for the foregoing reasons *Harris*, alone or in combination with *Chrabaszez*, fails to "teach or suggest all the Claim limitations" of claims 1, 5, 6, 8-11, 15, 16, 18, and 19, and Applicant respectfully requests that Examiner's § 103 rejections as to these claims be withdrawn. Specifically, the references fail to teach, *inter alia*, (1) a third party accessing a subset of user profile information, which is stored on a centralized database, and providing customized personal services to the user based on the subset of information; and (2) allowing the user to store and synchronize, with any Internet-enabled device, various activities on the same centralized database, as claimed in the present invention.


Conclusion

For at least the reasons stated above, Applicant submits that all pending claims are now allowable over the art of record and respectfully requests that a Notice of Allowance be issued in this case. If the Examiner believes that an additional conference would be of value in expediting the prosecution of this application, the undersigned can be reached at the telephone number listed below.

Should any additional fees be necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference #60021-303001).

Respectfully submitted,

By


Christopher R. Hilberg, Reg. No. 48,740
Customer No. 29838

Oppenheimer Wolff & Donnelly LLP
1400 Page Mill Road
Palo Alto, CA 94304-1124
Telephone: 612.607.7278
Facsimile: 612.607.7100
E-mail: WEdwards@oppenheimer.com

Page 9 of 15

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend claims 1, 5, 6, 8-11, and 16 as follows:

1. (Thrice Amended) A method for sharing ~~a~~ centralized user profile information to provide customized services to a user, comprising:
 - (a) ~~storing~~ obtaining user profile information in a centralized database, wherein the centralized database is Internet-accessible;
 - (b) ~~storing~~ obtaining at least one Activity ~~from a user device, in the centralized database, and wherein an~~ at least one Activity is a calendar object, email object, contact list object, task list object, or note object;
 - (c) ~~storing the user profile information and the Activity in a centralized, Internet-accessible database;~~
 - (c) ~~(d)~~ providing a user access to the centralized database from an Internet enabled device for allowing the user to update after the user profile information and to access the Activity, wherein a profile gateway server is configured between the Internet enabled device and the centralized database, and wherein the profile gateway server manages permissions and access to the centralized database server;
 - (d) ~~(e)~~ receiving permission from the user to allow a third party to access a public subset of the user profile information, wherein the profile gateway server manages access to the centralized database permitted to the third party;
 - (e) ~~(f)~~ providing the third party access to the public subset of the user profile information on the centralized database, wherein the profile gateway server is configured between the third party and the centralized database;
 - (f) ~~(g)~~ providing customized personal services ~~receiving content from the third party related to the Activity to the user, wherein the customized personal services are based on the public subset of the user profile information;~~
 - (g) ~~(h)~~ storing transaction information regarding the customized personal services the content from the third party in the centralized database; and
 - (h) ~~(i)~~ synchronizing the centralized database and an Internet enabled device so that the centralized database and the Internet enabled device both contain the content and the at least one Activities previously stored either on the Internet enabled device or on the centralized database.
5. (Twice Amended) The method for sharing ~~a~~ centralized user profile information to provide customized services to a user as recited in claim 1, further comprising updating a third-party application based on a change in the user profile information.

6. (Twice Amended) The method for sharing a centralized user profile information to provide customized services to a user as recited in claim 1, further comprising storing rules in the centralized database indicative of information usage in the user profile information.

8. (Twice Amended) The method for sharing a centralized user profile information to provide customized services to a user as recited in claim 1, wherein the profile information is grouped in an optimal manner for a third-party target application.

9. (Twice Amended) The method for sharing a centralized user profile information to provide customized services to a user as recited in claim 1, wherein the Internet enabled device is a gas meter, electricity meter, telephone, television, computer, smart card, pocket organizer, personal digital assistant, vehicle, kitchen appliances, lights, security system or home monitor.

10. (Thrice Amended) A system that manages supports a shared centralized user profile information to provide customized services to a user, comprising:

- (a) a processor;
- (b) a memory that stores information und